

## **Substantive Response to Office Action**

Reconsideration of this Application is respectfully requested in view of the discussion during the interview and the remarks set forth herein.

This Amendment is responsive to the Office Action dated December 21, 2000. Claims 1-60 are pending. Figures 1, 5, 7, 10-12, and 14-18 have been objected to. Claims 1, 6-7, 9, 17-19, 24, 30, 35, 39-45, 47-52 and 56-57 have been rejected under 35 U.S.C. §102(e) as anticipated by Chancey, U.S. Pat. No. 5,842,185 ("Chancey"). Claims 2-5, 8, 10-16, 20-23, 25-29, 31-34, 36-38, 46, 53-55, and 58-60 have been rejected as obvious under 35 U.S.C. §103 in view of Chancey alone, or as combined with one or more of Hilt et al., U.S. Pat. No. 6,032,133 ("Hilt"), Atkins, U.S. Pat. No. 5,875,437 ("Atkins") and/or Rosen U.S. Pat. No. 6,081,790 ("Rosen").

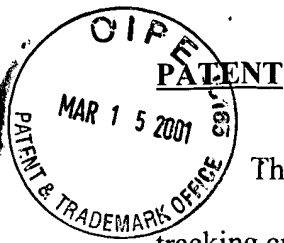
### Drawing Objections

With regard to the drawings, Formal Drawings correcting the margin and line thickness informalities will be supplied in due course upon receipt of an indication that the application contains allowable subject matter.

### Art Rejections

As will be set forth in greater detail below, all the rejections are respectfully traversed, withdrawal of all the art rejections is solicited, and allowance of all the claims is respectfully requested. In particular, as will be shown in greater detail below, it is respectfully submitted that the Office Action attributes teachings to the applied art that does not appear therein. Moreover, although the applied art relates generally to the same field as the instant invention, it is largely irrelevant to the claimed invention.

To assist the Examiner in considering the remarks below, a brief discussion of each of the applied references is provided.



The primary rejection reference, the Chancey patent, describes an arrangement for tracking credit card transactions made with a conventional credit card.

Hilt describes a bill payment arrangement that can be used with conventional credit cards.

Atkins describes a financial account management arrangement that allows for tracking and organizing of a persons various accounts.

Rosen describes an arrangement for secure presentment of invoices and secure payment using money modules over an open network.

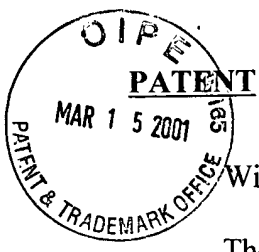
While, each of the above references generically fall into the category of payment arrangements, they do not at all relate to the claimed invention. Moreover, in many cases, they do not even describe what is attributed to them by the Office Action. Accordingly, it is respectfully submitted that all the rejections should be withdrawn.

The specific rejections will now be discussed with reference to the paragraph numbering in the Office Action.

#### The Anticipation Rejections

In paragraph 5 of the Office Action, col. 2, lines 4-34 of Chancey is cited as disclosing, *inter alia*, "accepting a selection of a first sequence of characters from a person making the request (col 2 lines 19-27) and accepting a second sequence of characters which identify an entity unrelated to the person (col 2 lines 27-34) and combining the first sequence of characters and the second sequence of characters into a cardholder name (col 2 lines 34-39)[.]"

However, col. 2, lines 19-39 of Chancey relates to categorizing financial transactions with a payee to a particular category, for example, a SIC code. Nowhere in that passage is even the concept of a "cardholder name" suggested, let alone one defined as made up of a "first sequence of characters from a person making the request" and "second sequence of characters which identify an entity unrelated to the person."



Withdrawal of the rejection of paragraph 5 and allowance of claim 1 is requested.

The rejection in paragraph 6 of the Office Action is inconsistent with paragraph 5 in that, although the defined "cardholder name" and "name" are similar, col. 4, lines 1-5, rather than col. 2, lines 19-39, is cited as teaching the "name" as it is defined in the claim. Col. 4, lines 1-5 continue to relate to the categorization as cited in col. 2 and suffers from the same deficiencies. In other words, neither the cited passage of col. 4, nor the cited passage of col. 2 remotely provide the disclosure attributed to them by the Office Action.

Withdrawal of the rejection of paragraph 6 and allowance of claim 6 is requested.

The rejections of paragraphs 7-10, relate to claims dependent (directly or indirectly) from claim 6 and suffer from the same problem. Moreover, in paragraph 9, col. 3, lines 18-24 is cited for the teaching that "the second part is a proxy for a surname." The cited passage, however, states:

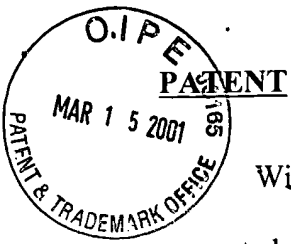
The program 20 may include a number of features such as a bank account 22 (checking, savings and the like), a credit card account 24 and other accounts. Through registers that are graphically displayed by the computer 10 on the video display terminal, a user can track income and expenditures from these accounts more quickly and accurately than through paper registers.

It is unclear to the applicants and the undersigned where in the cited passage or, presuming the citation is a typographical error, the Chancey patent, such a teaching can be found.

Similarly, as noted above, the passage cited in paragraph 10 has nothing to do with a "name" as that term is defined.

Withdrawal of the rejections of paragraphs 7-10 and allowance of claims 7, 9, 17 and 18 is requested.

The rejections of paragraphs 11-13 suffer from the same deficiencies with regard to the "name", the "first part" and the "second part" noted above with respect to paragraphs 5 and 6.



Withdrawal of the rejection of paragraphs 11-13 and allowance of claims 19, 24 and 30 is requested.

The rejections of paragraphs 14-15 are equally deficient with regard to the "cardholder name" as claimed.

Withdrawal of the rejections of paragraphs 14-15 and allowance of claims 35 and 39 is requested.

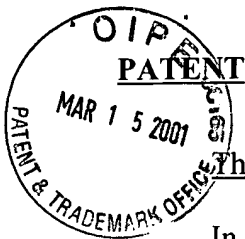
The rejection of paragraph 16 of the Office Action attributes to col. 4, lines 22-42 "anonymizing the financial services account." However, the cited section merely describes using a checksum to verify that a statement had not been altered. It is respectfully submitted that using a checksum for authentication does not equate to "anonymizing the financial services account" as attributed by the Office Action.

Withdrawal of the rejection of paragraph 16 and allowance of claim 40 is requested.

The rejections of paragraphs 17-29 similarly suffer from the various "cardholder name" related deficiencies noted above.

Withdrawal of the rejections of paragraph 17-29 and allowance of claims 41-42, 44-45, 47-52 and 56-57 is requested.

In sum, it is respectfully submitted that Chancey does not, and can not, anticipate any of claims 1, 6, 7, 9, 17-19, 24, 30, 35, 39-42, 44-45, 47-52 and 56-57. Accordingly, it is respectfully submitted that claims 1, 6, 7, 9, 17-19, 24, 30, 35, 39-42, 44-45, 47-52 and 56-57 are all allowable and early favorable action in that regard is solicited. Moreover, it is respectfully submitted that claims 2-5, 8, 10-16, 25-29, 31-34, 36-38, 43, 46, and 53-55 all depend directly or indirectly from an allowable claim. Accordingly, those claims are also allowable for the same reason.



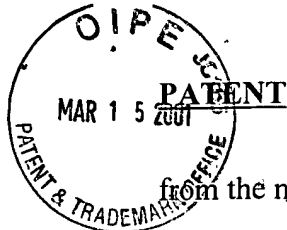
The Obviousness Rejections

In paragraphs 30-70 of the Office Action, claims 2-5, 8, 10-16, 20-23, 25-29, 31-34, 36-38, 46, 53-55, and 58-60 have been rejected as obvious under 35 U.S.C. §103 based upon Chancey alone, or in combination with one or more of Atkins, Hilt and/or Rosen.

Without belaboring the point, it is noted that Chancey is relied upon in all cases for supplying one or more of the "cardholder name", "name", "first part" and "second part" of the appropriate claims. It is respectfully submitted that, to the extent any of Atkins, Hilt or Rosen do not disclose what is attributed to them in the Office Action, those deficiencies stand as a further basis for withdrawal of the rejections and allowance of the claims. Moreover, the Office Action never attributes any such aspects to any of Atkins, Hilt or Rosen and neither applicants nor the undersigned are able to find such aspects therein. Thus, irrespective of whether those references do or do not disclose what is attributed to them, none of those references remedy the deficiencies of Chancey. Accordingly, withdrawal of the obviousness rejections set forth in paragraphs 30-70 is also requested.

Moreover, the obviousness rejections are further traversed because they do not follow the MPEP requirements for an obviousness rejection. The MPEP at §§ 2141-2143.03 sets out that a proper obviousness rejection must show "the three basic criteria" of a prima facie case: (1) motivation to combine or modify the references to the specific combination of elements recited in the claims, (2) reasonable expectation of success, and (3) every element of the claim shown in the art. It is respectfully submitted that none of the three are satisfied.

The MPEP identifies three permissible sources for motivation to combine references. First, the suggestion may come expressly from the references themselves. Second, it may come from knowledge of those skilled in the art that certain references, or disclosures in the references, are known to be of special interest or importance in the particular field. Third, it may also come



from the nature of a problem to be solved, an identifiable aspect of a narrowly-defined and recognized problem that leads inventors to look to references relating to possible solutions to that problem. None of the three are present here.

There is nothing in the Chancey, Atkins, Hilt and/or Rosen references themselves that suggests the combinations set forth in any pertinent paragraph of the Office Action. Each reference teaches a complete embodiment, without a “loose end” in search of an improvement drawn from the other, or an advantage that suggests application to the other in a manner that would result in the claimed invention.

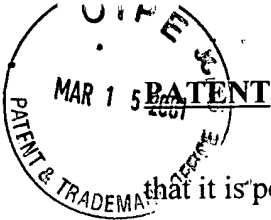
There is also no indication in the record, nor information known to Applicants, that those references have attained the status of standard reference works known to be of special interest to those of skill in the art.

Additionally, the rejections identify no narrow problem that would satisfy the “nature of the problem to be solved” prong of motivation to combine which would suggest the particular combinations set forth in the Office Action. Indeed, all of the references are directed to significantly different problems than those addressed by Applicants' invention.

Failing satisfaction of the above, there is no motivation available in the prior art to combine the two references, particularly in the manners posited by the Office Action.

The Office Action also repeatedly states, in rejecting various claims, that it would have been obvious to combine two or more of the references; relying upon statements of motivations not in any of the prior art of record. The Office Action does not provide a statement from the prior art which provides the cited motivation to combine the references as stated or that any modification necessary for combining the two as posited was known to be desirable.

The Office Action has also not provided any statement in the prior art that would provide a reasonable expectation of success for any such modification (MPEP § 2143.02): for instance,



that it is possible to modify the applied references in a manner which would accomplish the claimed invention without significantly changing either or both in a manner that would render one or both unsuitable for its described purpose.

Finally, the Office Action has not provided evidence that all elements of the claims (MPEP § 2143.03) are in the prior art. Specifically the Office Action does not cite any prior art having any of the "cardholder name", "name", "first part" or "second part" elements as recited in several of the claims. If these statements are found in the prior art, specific citation is respectfully requested. If these statements are not found in the prior art, then the claims must be allowed.

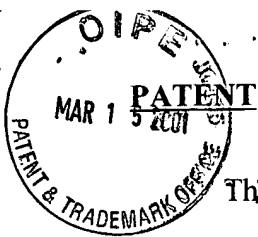
Accordingly, it is respectfully submitted that the rejections of paragraphs 30-70 should be withdrawn, claims 2-5, 8, 10-16, 20-23, 25-29, 31-34, 36-38, 46, 53-55, and 58-60 are not obvious and they are all allowable.

#### **Information Disclosure Statement**

As a final matter, it is noted that on February 21, 2001, an Information Disclosure Statement, PTO-1449 and copies of the cited references were filed for consideration in the instant case. Consideration of those references on the merits is respectfully requested and return of an initialed copy of the PTO-1449 with the next communication is respectfully requested.

#### **CONCLUSION**

It is respectfully submitted that, as shown above, none of the applied references disclose certain aspects attributed to them. Accordingly, it is respectfully submitted that the rejections of claims 1-60 must be withdrawn, the claims should all be allowed and the application be passed to issue in due course.



The Examiner is urged to telephone Applicants' undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance.


Although no extension of time is believed necessary, in the event that an extension of time is required, Applicants hereby petition for such extension of time required to make this response timely. In the event any fee is due for consideration of this Response, kindly charge any such fee, or credit any surplus, to Deposit Account 13-4500, order number 3606-4001.

Respectfully submitted,

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